

Serial No. 09/782,718

Patent
58104-00003

APR 27 2003
#17

4000
I hereby certify that on February 18, 2003, this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, DC 20231.

37 C.F.R. § 1.8(a) 37 C.F.R. § 1.10
 with sufficient postage as "Express Mail Post Office to Addressee" Mailing Label No. EV 073564192 US

Rita Soto

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Stephen P. Hamilton

Title: **Apparatus and Method for
Transporting Motorcycles**

Serial No. 09/782,718

Filed: February 13, 2001

Group Art Unit: 3652

Examiner: Steven A. Bratlie

APPELLANT'S BRIEF ON APPEAL (37 C.F.R. § 1.192)

Sung I. Oh
SQUIRE, SANDERS & DEMPSEY LLP
801 S. Figueroa Street, 14th Floor
Los Angeles, CA 90017-5554
Telephone: (213) 624-2500
Facsimile: (213) 623-4581

1. REAL PARTY IN INTEREST

Steven P. Hamilton (“the Applicant”) is the solo-inventor of U.S. Patent Application Serial No. 09/782,718 (“the Application”) and has no duty to assign the Application. Accordingly, the Applicant is the real party in interest of this Appeal.

2. RELATED APPEALS AND INTERFERENCES

The Application is not involved in any other appeals or interferences.

3. STATUS OF CLAIMS

The Application was originally filed with 47 claims. In the Office Action dated April 18, 2002, the Examiner restricted the claims according to the following figures as being patentably distinct species of the claimed invention: (A) Figures 1-11; (B) Figures 12-20; (C) Figure 21; (D) Figure 22; (E) Figure 23; and (F) Figure 24. In response to the Restriction Requirement, the Applicant with traverse elected claims directed to Figure 24, and cancelled claims 46 and 47, and added new claims 48-52. In the first substantive Office Action dated August 9, 2002, the Examiner withdrew claims 2, 3-17, 19-21, and 23-44 for being drawn to a nonelected species of claims, and rejected the pending claims 1, 4, 18, 22, 45, and 48-52. In the Final Office Action dated December 18, 2002, the Examiner again rejected the pending claims. The claims on Appeal are 1, 4, 18, 22, 45, and 48-52.

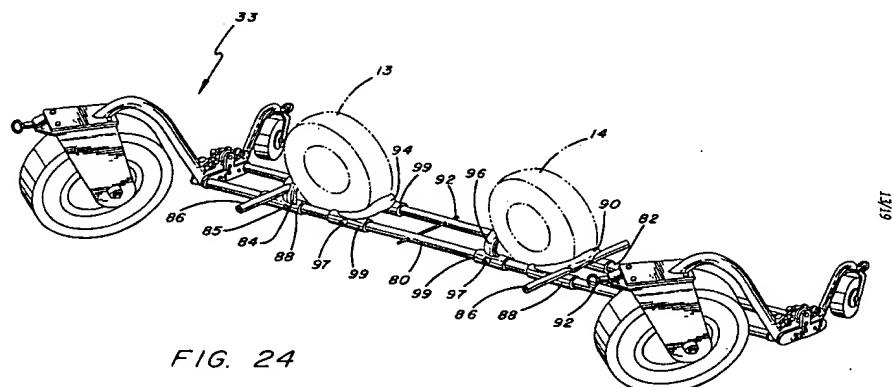
4. STATUS OF AMENDMENTS

In the first substantive Office Action dated August 9, 2002, the Examiner rejected the pending claims 1, 4, 18, 22, 45, and 48-52 under 35 U.S.C. 103(a) as being unpatentable over Matovich U.S. Pat. No. 4,491,452, in view of British Patent #2,326,632, Siebert U.S. Pat. No. 4,681,299, and Scott U.S. Pat. No. 5,234,307. A response was filed on November 4, 2002 with arguments to overcome the rejection, but the Final Office Action dated December 18, 2002, rejected all the pending claims for the second time. Whereupon a Notice of Appeal was filed on January 15, 2003. The claims on Appeal are 1, 4, 18, 22, 45, and 48-52.

Before the Appeal Brief was filed, the representative of the Applicant called the Examiner to request a telephone interview. The Examiner's position was that without amending the claims, the telephone would not assist in advancing the prosecution of the Application. The representative stated the Applicant's position to the Examiner that claims are allowable over the cited reference without any amendment. With this dispute, the Applicant hereby files this Appeal Brief.

5. SUMMARY OF INVENTION

The invention is generally directed to an apparatus and method for transporting a motorcycle as shown in Figure 24 of the application, which is reproduced below for convenience. The invention allows a user to lift at least one end of the motorcycle so that the motorcycle may be moved around in a garage or maneuvered onto the back bed of a tow truck. The transportation apparatus includes a pair of cradle bars (80 and 82) that are positioned on the opposite sides of the two wheels of the motorcycle. A first front chock (84) may be placed on the front side of the first wheel (13) to hold the first wheel in place. A first rear chock (90) may be placed on the back side of the second wheel (14) to hold the second wheel in place. Straps may be used to secure the vehicle onto the transportation apparatus. A dolly (33) is coupled to one or both opposing ends of the pair of cradle bars (80 and 82).



To lift the pair of cradle bars along with the motorcycle, the dolly (33) is activated to lift that end of the cradle bars. To lift both ends, both dollies are activated. The dolly (33) may include an actuator that causes the dolly to extend two of its arms to raise the transportation apparatus off the floor. Once lifted, the two wheels on the dolly allow the transportation apparatus to be maneuvered with ease to move the vehicle from one place to another or moved onto a back bed of a tow truck.

6. ISSUES

I. Whether there is a teaching, motivation, or suggestion to select and combine the references relied on by the Examiner to reject the claimed invention as being obvious under 35 U.S.C. 103(a)?

II. Even if the references relied on by the Examiner could be combined, whether the claimed invention would be obvious in view of the combined references under 35 U.S.C. 103(a)?

7. GROUPING OF CLAIMS

The claims 1, 4, 18, 22, 45, and 48-52 are one group of claims that stand or fall together.

8. ARGUMENT

Issue I:

There is no teaching, motivation, or suggestion to combine the references cited by the Examiner to reject the claimed invention as being obvious under 35 U.S.C. 103(a).

A. The Examiner's Rejections

In the first and second Office Actions dated August 9, 2002 and December 18, 2002, respectively, the Examiner rejected claims 1, 4, 18, 22, 45, and 48-52 under 35 U.S.C. 103(a) as being obvious over Matovich U.S. Pat. No. 4,491,452, in view of British Patent #2,326,632, Siebert U.S. Pat. No. 4,681,299, and Scott U.S. Pat. No. 5,234,307. The Examiner asserted that Matovich discloses a substantially similar transporter as shown in Figures 6 and 7, then noted that various numbers of lifting units can be used to move loads of any shape or size. The Examiner then asserts that “[i]t is apparent that a motorcycle can be transported using two

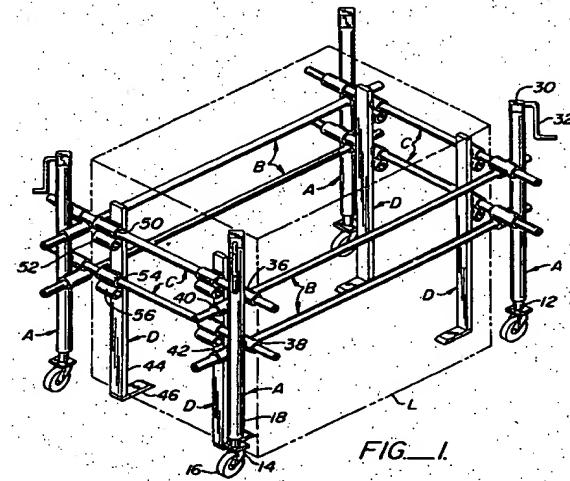
[lifting] units." The Examiner, however, does state that Matovich lacks the specific type of an actuator as taught in the application to lift the transporter, but combines the transporter in Matovich with the actuators disclosed in the British and Siebert patents to obviate the claimed invention. Scott is relied upon to disclose that the transporter can be loaded onto a truck, but not relied upon to reject the independent claims.

B. Three Principle References Relied on by the Examiner: Matovich, the British Patent, and Siebert.

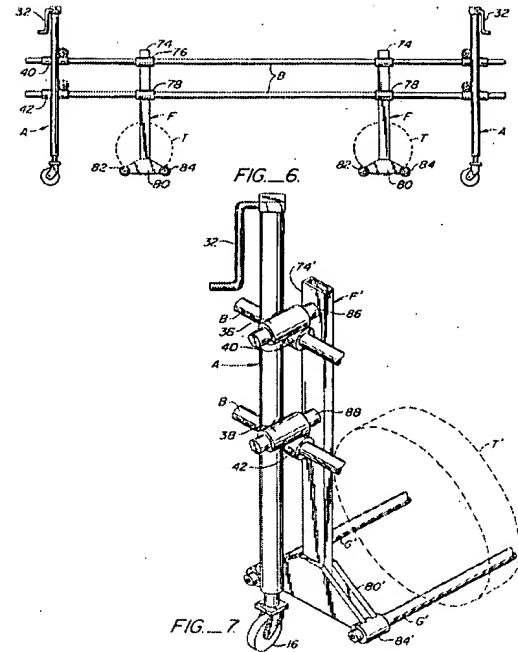
1. Matovich Does Not Teach or Suggest Lifting a Motorcycle.

Figure 1 of Matovich is reproduced below which shows a transporting apparatus with four identical lifting units A at the four corners of the load L. The transporting apparatus is designed to lift air conditioning units and differently shaped articles such as cylindrical or spherical tank. See Column 1, lines 13 and 14, and Column 4, lines 50 and 51.

In addition, Matovich discloses a transporting apparatus as shown to the right in Figures 6 and 7 used to lift an automobile. See Column 5, lines 20-30. Four load engaging units F are used to lift the four tires, two units for the two front tires and two units for the two rear tires. See Column 5, lines 55-58. Each engaging unit F has pairs of crossbars G positioned under the tire T. To lift the front and rear vehicle axles, the cranks 32 are rotated so that the four lifting units A can lift the automobile off the floor. See Column 5, lines 50-68.

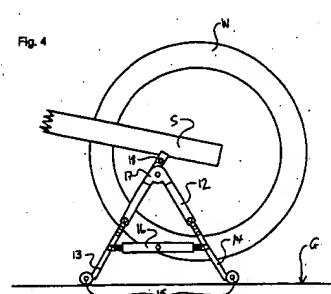
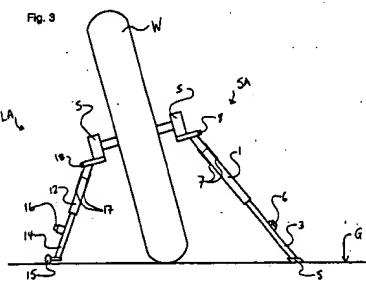
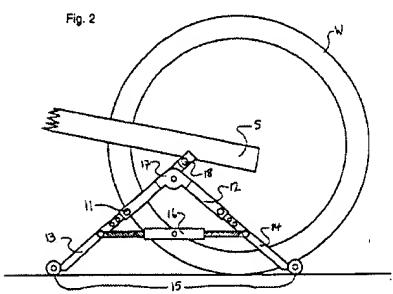


The Examiner asserts that it is apparent that two lifting units A can be used to transport a motorcycle. Using two lifting units A on one side of the motorcycle, however, would only raise one side and tilt the motorcycle over. Moreover, the elongated bars B on the transporting apparatus would likely entangle with the handlebar of the motorcycle so that it would be difficult, if at all, to lift the motorcycle. Accordingly, Matovich does not teach, motivate, or suggest using the transporting apparatus for lifting a motorcycle with two wheels.



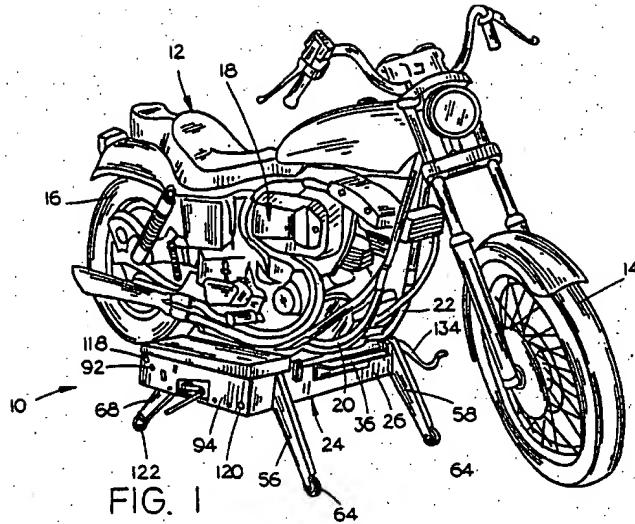
2. The British Patent.

Figures 2, 3, and 4 of the British patent reproduced below discloses a motorcycle jack for lifting one wheel of the motorcycle. This is done by coupling the support assembly (SA) to the spindle of the wheel on one side, and coupling the lifting assembly (LA) to the same spindle on the other side of the wheel. To lift the wheel, the adjustable strut 16 on the LA is rotated to raise the wheel.



3. Siebert.

Figure 1 of Siebert discloses a motorcycle jack to the right that is positioned underneath the motorcycle 12 to lift the entire motorcycle. This allows the front and rear wheels to be suspended freely so that the front and rear wheels can be removed. See Column 2, lines 31-37. The power to raise and lower the jack is provided by the hydraulic cylinder unit 86 that extends the pair of front legs 56 and 58 and the pair of rear legs 68 and 79. See Column 3, lines 53-55.



C. Analysis: There are no Teaching, Motivation, or Suggestion to Combine the References Cited by the Examiner.

In this case, there are at least three reasons for not combining Matovich with the British Patent and/or Siebert. First reason is that Matovich is directed to a different art than the British patent and Siebert. Matovich is directed to lifting an automobile having four wheels using four lifting units A, whereas the British and Siebert patents are directed to a jack for lifting a motorcycle having two wheels. As such, Matovich is directed to a different art than the British and Siebert patents so that there is no teaching, suggestion, or motivation to combine these references.

The second reason for not combining the references is that the Examiner does not provide relevant evidence to suggest that the cited references can be combined. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.¹ In the Final Office Action dated

¹ McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).

December 18, 2002, the Examiner relies on the disclosure of Matovich in Column 1, lines 34-40 and Column 7, lines 19-27 as evidence that the transporting apparatus as taught by Matovich can be used to transport a motorcycle. According to the Examiner, Matovich discloses that "various number of [lifting] units can be used to move loads of 'any shape or size can be transported'." Based on this disclosure, the Examiner concludes that "[i]t is apparent that a motorcycle can be transported using two [lifting] units." Such interpretation or conclusion by the Examiner is not consistent with the teaching of Matovich because it discloses that various loads can be transported such as air conditioning units and differently shaped articles such as cylindrical or spherical tank. See Column 1, lines 13 and 14, and Column 4, lines 50 and 51. But nowhere does Matovich teach, motivate, or suggest using less than four engaging units F or four lifting units A to lift or move the load L, especially a motorcycle. As such, there is no evidence to teach, motivate, or suggest that the transporting apparatus of Matovich can be adapted to move a motorcycle.

Even if two lifting units A are used on the side to lift the motorcycle, it would only raise one side, which would cause the motorcycle to tilt over. Moreover, the elongated bars B on the transporting apparatus would likely entangle with the handlebar of the motorcycle so that it would be difficult to lift the motorcycle. Accordingly, there is no evidence to support the Examiner's position that the transporting apparatus of Matovich can be used to lift a motorcycle.

The third reason for not combining Matovich with the British patent and/or Siebert is that the combination would create a redundancy, and therefore the proposed modification would be unsatisfactory for its intended purpose. In Matovich, the load engaging unit F is distinct from the lifting unit A. Four engaging units F are used to engage underneath the four tires of the automobile, then the four lifting units A on the four corners are used to lift the engaging units F along with the four tires. In contrast, in the British patent and Siebert, the engaging and the lifting of the motorcycle are all done by the motorcycle jack. Therefore, if Matovich is combined with the teaching of the British patent, then the combined transporting apparatus would have two lifting apparatuses on each corner or total of eight lifting units: one lifting unit A and the motorcycle jack for each wheel. Redundancy would occur, and therefore it would be

unsatisfactory for its intended purpose. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.² As such, one skilled in the art would not combine the teachings of Matovich with the British Patent. Likewise, combining Matovich with Siebert would result in redundancy as well, so that one skilled in the art would not combine the two references. Hence, it is respectfully submitted that based on the above distinction alone, the references relied on by the Examiner cannot be combined to obviate the claimed invention in the application.

Issue II:

Even if the references relied on by the Examiner were combined, the combination of references do not obviate the claimed invention under 35 U.S.C. 103(a).

The claimed invention of this Application is generally directed to an apparatus and method for transporting a motorcycle. The invention allows a user to lift one or both ends of the motorcycle. To accomplish this the transportation apparatus includes a pair of cradle bars (80 and 82), which are positioned along the longitudinal axis of the front and back wheels (13 and 14) of the motorcycle such that both wheels are between the pair of cradle bars. In this regard, the following pending independent claims recite in part:

Claim 1: “a pair of cradle bars releasably coupled to the first front and first second chocks, wherein the first and second wheels are positioned between the pair of cradle bars.”

Claim 22: “positioning a first cradle bar substantially parallel to a longitudinal axis defined by a first wheel and a second wheel; positioning a second cradle bar opposite said first cradle bar and substantially parallel to the longitudinal axis defined by the first wheel and the second wheel.”

Claim 48: “a first cradle bar adapted to associate with a side of first and second wheels of a cycle along a longitudinal axis; a second cradle bar adapted to associate with an opposite side of the first and second wheels of the cycle along the longitudinal axis.”

In contrast, Figures 6 and 7 of Matovich disclose two elongated bars B running along the longitudinal axis of the two tires T, but the two elongated bars B are on the outer side of the

²See M.P.E.P. § 2143.01.

wheels T. That is, Matovich does not teach or suggest having one elongated bar B on one side of the wheel and a second elongated bar B on the opposite side of the wheel. Likewise, the British and Siebert patents do not teach or suggest having one elongated bar on one side of the front and rear wheels and another elongated bar on the opposite side of the wheels. Therefore, it is respectfully submitted that references cited by the Examiner even when combined do not teach or suggest the claimed invention under 35 U.S.C. 103(a).

9. CONCLUSION

In view of the foregoing, it is respectfully submitted that there is no teaching, suggestion, or motivation to combine Matovich with the British Patent and/or Siebert. Even if these references were combined, they still do not teach or suggest the claimed invention with a cradle bar on each side of the front and rear wheels of the motorcycle. Accordingly, it is respectfully submitted that the independent claims 1, 22, and 48 and their respective dependent claims are in condition for allowance.

The Board is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefore.

Respectfully submitted,



Sung I. Oh
Attorney for Applicant

SQUIRE, SANDERS & DEMPSEY LLP
801 S. Figueroa Street, 14th Floor
Los Angeles, CA 90017-5554
Telephone: (213) 624-2500
Facsimile: (213) 623-4581

10. APPENDIX

CLAIMS ON APPEAL

1. An apparatus assembly for transporting a cycle, comprising:
a first front chock adapted to associate with the front side of a first wheel of a cycle;
a first rear chock adapted to associate with the back side of a second wheel of the cycle;
a pair of cradle bars releasably coupled to the first front and first second chocks, wherein
the first and second wheels are positioned between the pair of cradle bars; and
a dolly adapted to couple to a first end of each of the cradle bars extending from the first
front chock, said dolly having an actuator and a pair of arms, each of said arms having a pivotal
end and a free end, said pivotal end of each of said arms pivotally coupled to the actuator.
4. The apparatus of claim 1, further comprising a second dolly adapted to couple to a
second end of each of the pair of side bars extending from the first rear chock, said dolly having
an actuator and a pair of arms, each of said arms having a pivotal end and a free end, said pivotal
end of each of said arms pivotally coupled to the actuator.
18. The apparatus of claim 1, wherein the dolly is used to raise the first and second
wheels of the motorcycle to roll the motorcycle on to a bed of a tow truck.
22. A method for transporting a cycle, comprising:
positioning a first cradle bar substantially parallel to a longitudinal axis defined by a first
wheel and a second wheel;
positioning a second cradle bar opposite said first cradle bar and substantially parallel to
the longitudinal axis defined by the first wheel and the second wheel;
placing a first front chock substantially adjacent to a front side of the first wheel to define
a first position, wherein the first front chock is releasably coupled to the first and second cradle
bars;
securing the first front chock in the first position;

placing a first rear chock substantially adjacent to a back side of the second wheel to define a second position, wherein the first rear chock is releasably coupled to the first and second cradle bars;

securing the first rear chock in the second position; and

coupling a dolly to a first end of each of the first and second cradle bars extending from the first front chock.

45. The method of claim 22, further comprising coupling a second dolly to a second end of each of the first and second cradle bars extending from the first rear chock, said dolly having an actuator and a pair of arms, each of said arms having a pivotal end and a free end, said pivotal end of each of said arms pivotally coupled to the actuator.

48. An apparatus for transporting a cycle, comprising:

a first cradle bar adapted to associate with a side of first and second wheels of a cycle along a longitudinal axis;

a second cradle bar adapted to associate with an opposite side of the first and second wheels of the cycle along the longitudinal axis;

a first front chock adapted to associate with a front side of the first wheel and adapted to associate with the first and second cradle bars;

a first rear chock adapted to associate with a back side of the second wheel and adapted to associate with the first and second cradle bars;

a first dolly adapted to couple to the first and second cradle bars in front of the first wheel to lift the first wheel off a ground; and

a second dolly adapted to couple to the first and second cradle bars in back of the second wheel to lift the second wheel off the ground.

49. The apparatus according to claim 48, where the first dolly and the second dolly each has an actuator and a pair of arms, each of the arms having a pivotal end and a free end, the pivotal end of each of the arms pivotally coupled to the actuator.

50. The apparatus according to claim 48, further including a second front chock adapted to associate with a back side of the first wheel.

51. The apparatus according to claim 48, further including a second rear chock adapted to associate with a front side of the second wheel.

52. An apparatus for transporting a cycle, comprising:
means for lifting a first wheel of a cycle off a ground;
means for lifting a second wheel of a cycle off the ground; and
means for transporting the cycle onto a back-bed of a tow truck.

LosAngeles/105303.1



02-20-003

EXPRESS MAIL NO. EV 073564192 US

I hereby certify that the Brief on Appeal and attached documents, pursuant to 37 C.F.R. §1.10, are being deposited as "Express Mail" this date with the United States Postal service in an envelope addressed to Commissioner of Patents, Washington, D.C. 20231, on

Date: February 18, 2003

By Rita M. Soto
Rita M. Soto

**IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE**

Applicant(s): Stephen P. Hamilton

Docket No.: 58104-00003

Application No.: 09/782,718

Group Art Unit: 3652

Filing Date: February 13, 2001

Examiner: Steven A. Bratlie

TITLE: **Apparatus and Method for Transporting Motorcycles**

Commissioner for Patents
Washington, DC 20231

RECEIVED

FEB 25 2003

GROUP 3600

**TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION-37 C.F.R. §1.192)**

1. Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on January 15, 2003.

2. STATUS OF APPLICANT

This application is on behalf of

[] other than a small entity.
[] a small entity.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. §1.17(c), the fee for filing the Appeal Brief is:

[<input checked="" type="checkbox"/>] small entity	\$160.00
[<input type="checkbox"/>] other than a small entity	\$320.00

Appeal Brief fee due \$160.00



If an additional extension of time is required, please consider this a petition therefore.

(b) Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

4. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$160.00

TOTAL FEE DUE \$160.00

5. FEE PAYMENT

Attached is a Squire, Sanders & Dempsey L.L.P. check in the amount of \$160.00.

6. FEE DEFICIENCY

The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under 37 C.F.R. §§1.16-1.18 (deficiency only) now or hereafter relative to this Application and the resulting Official document under 37 C.F.R. §1.20, or credit any overpayment to Deposit Account No. 19-3878 for which purpose a duplicate copy of this sheet is attached. This statement does NOT authorize charge of the issue fee.

Respectfully submitted,

RECEIVED

FEB 25 2003

GROUP 3600

February 18, 2003

Date

By



Sung I. Oh
Reg. No. 45,583

SQUIRE, SANDERS & DEMPSEY L.L.P.
801 S. Figueroa Street, 14th Floor
Los Angeles, CA 90017-5554
Telephone: (213) 624-2500
Facsimile: (213) 623-4581

Los Angeles/106816.1